REMARKS / ARGUMENTS

The present application includes pending claims 1-21, all of which have been rejected. Applicants have amended claims 1-10, 13-15, 17, and 20-21 to further prosecution of the claims and to clarify the language used in these claims in light of the recent Federal Circuit decision in *SuperGuide Corp. v. DirecTV Enterprises, Inc., et al.*, 358 F.3d 870 (Fed. Cir. 2004). Applicants do not believe that these amendments affect allowability of the claims.

Claims 1-5 and 7-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,891,819 issued to Inoue, et al. (hereinafter, Inoue) in view of U.S. Patent Application Publication 2002/0120871 issued to Watkins, et al. (hereinafter, Watkins). Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Inoue in view of Watkins in further view of U.S. Patent 5,748,084 issued to Isikoff (hereinafter, Isikoff).

Applicants request reconsideration of the claims in view of the amendments and the following remarks.

Claim Objection

(paragraph 2 of the Office Action)

Applicants have amended claim 8 to further clarify the claim language in light of the recent Federal Circuit decision in *SuperGuide Corp. v. DirecTV Enterprises, Inc., et al.*, 358 F.3d 870 (Fed. Cir. 2004). The Applicants submit that no new matter has been entered by the amendment of claim 8.

Further with regard to the Examiner's objection of claim 8, Applicants respectfully disagree with the Examiner's narrow interpretation of the term "processor." It appears from the Office Action that the Examiner has interpreted the term "processor" to be a central processing unit, or a CPU. Applicants

respectfully disagree with such narrow interpretation. Applicants submit that the specification, at least with regard to paragraphs [11] to [66], support the subject matter of independent claim 7 and dependent claim 8. In this regard, Applicants submit that in the context of at least the relevant description of FIGs. 1-2B, a processor as claimed in claim 7, may also comprise an integrated circuit (e.g., ASIC), a personal computer or a set top box, as claimed by Applicants in claim 8. Applicants, therefore, respectfully traverse the objection to claim 8.

Claim Rejections under 35 U.S.C. § 103

(paragraphs 4 and 5 of the Office Action)

Claims 1-5 and 7-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Inoue in view of Watkins. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Inoue in view of Watkins in further view of Isikoff.

With regard to an obviousness rejection, MPEP 2142 states that in order for a *prima facie* case of obviousness to be established, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* Further, MPEP 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be *a suggestion or motivation in the reference* to do so'" (citing In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)).

Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...," citing Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999).

With regard to the third criterion stated above and in reference to independent claim 1, Applicants submit that neither Inoue nor Watkins disclose or suggest at least the limitation of "receiving validation information, after said registering, relating to the communication device, the validation information entered via the communication device," as claimed by Applicants in independent claim 1. Inoue teaches user authentication via a user authentication unit located in a home network, where the user authentication unit carries out a user authentication **prior to registration** of the information on the current location of the mobile computer (Inoue, col. 3, lines 12-31). In this regard, Inoue does not teach receiving validation information after registration of a communication device, where the validation information is entered via the communication device, as claimed by Applicants in claim 1.

Additionally, with regard to the third criterion stated above and in reference to independent claim 1, Applicants submit that neither Inoue nor Watkins disclose or suggest at least the limitation of "determining whether the communication device is authorized for use in the communication network, based on at least the validation information entered via the communication device," as claimed by Applicants in independent claim 1. The Examiner states in the Office Action (page 3) that Inoue does not disclose determining whether the communication device is authorized for use in the communication network, as called for in independent claim 1. The Applicants respectfully agree.

In addition, the teachings of Watkins disclose granting access to a host communication system by "**locating a memory segment** within the client communication system that stores client software used to access the host computer system" (Watkins, page 1, paragraph 6). In this regard, Watkins does

not teach or disclose "determining whether the communication device is authorized for use in the communication network, **based on at least the validation information entered via the communication device**," as claimed by Applicants in independent claim 1.

Furthermore with respect to the rejection of claims 2-5, which depend from independent claim 1, the Applicants respectfully submit that Inoue in view of Watkins does not render claims 2-5 unpatentable at least for the reasons discussed above with respect to independent claim 1.

With regard to the third criterion stated above and in reference to independent claim 7, Applicants submit that neither Inoue nor Watkins disclose or suggest at least the limitation of "determines whether the communication device is authorized for use in the communication network, based on the received validation information," as claimed by Applicants in independent claim 7. The Examiner states in the Office Action (page 4) that Inoue does not disclose of determining whether the communication device is authorized for use in the communication network, as called for in independent claim 7. The Applicants respectfully agree.

In addition, the teachings of Watkins disclose granting access to a host communication system by "**locating a memory segment** within the client communication system that stores client software used to access the host computer system" (Watkins, page 1, paragraph 6). In this regard, Watkins does not teach or disclose "determines whether the communication device is authorized for use in the communication network, **based on the received validation information**," as claimed by Applicants in independent claim 7.

Furthermore with respect to the rejection of claim 8, which depends from independent claim 7, the Applicants respectfully submit that Inoue in view of Watkins does not render claim 8 unpatentable at least for the reasons discussed above with respect to independent claim 7.

With regard to the third criterion stated above and in reference to independent claim 9, Applicants submit that neither Inoue nor Watkins disclose or suggest at least the limitation of "determining whether to grant the communication device access to the communication network, based on the validation information entered via the communication device," as claimed by Applicants in independent claim 9. The Examiner states in the Office Action (page 5) that Inoue does not teach or disclose whether to grant the communication device access to the communication network, as called for in independent claim 9. The Applicants respectfully agree.

In addition, the teachings of Watkins disclose granting access to a host communication system by "**locating a memory segment** within the client communication system that stores client software used to access the host computer system" (Watkins, page 1, paragraph 6). In this regard, Watkins does not teach or disclose "determining whether to grant the communication device access to the communication network, **based on the validation information entered via the communication device**," as claimed by Applicants in independent claim 9.

Furthermore with respect to the rejection of claims 10-14, which depend from independent claim 9, the Applicants respectfully submit that Inoue in view of Watkins does not render claims 10-14 unpatentable at least for the reasons discussed above with respect to independent claim 9.

With regard to the third criterion stated above and in reference to independent claim 15, Applicants submit that neither Inoue nor Watkins disclose or suggest at least the limitation of "determining whether to grant access of the media device to the first home environment via the communication network, based on the validation information entered via the media device," as claimed by Applicants in independent claim 15. The Examiner states in the Office Action (page 7) that the teachings of Inoue do not teach or disclose of determining

whether to grant the communication device access to the first environment, as called for in independent claim 15. The Applicants respectfully agree.

In addition, the teachings of Watkins disclose granting access to a host communication system by "**locating a memory segment** within the client communication system that stores client software used to access the host computer system" (Watkins, page 1, paragraph 6). In this regard, Watkins does not teach or disclose "determining whether to grant access of the media device to the first home environment via the communication network, **based on the validation information entered via the media device**," as claimed by Applicants in independent claim 15.

Furthermore with respect to the rejection of claims 16-21, which depend from independent claim 15, the Applicants respectfully submit that Inoue in view of Watkins does not render claims 16-21 unpatentable at least for the reasons discussed above with respect to independent claim 9.

Furthermore with respect to the rejection of dependent claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Inoue in view of Watkins in further view of Isikoff, the Applicants respectfully submit that Inoue in view of Watkins in further view of Isikoff do not render dependent claim 6 unpatentable at least for the reasons discussed above with respect to independent claim 1.

Based on at least the foregoing, Applicants believe the rejection of independent claims 1, 7, 9, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Inoue in view of Watkins has been overcome and request that the rejection be withdrawn. Additionally, Applicants believe the rejection of dependent claims 2-5, 8, 10-14, and 16-21 under 35 U.S.C. § 103(a) as being unpatentable over Inoue in view of Watkins has also been overcome and requests that the rejection be withdrawn.
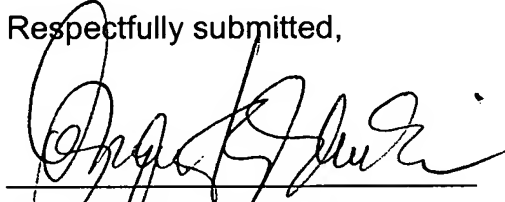
CONCLUSION

Based on the foregoing, Applicant believes that all claims 1-21 are in condition for allowance. If the Examiner disagrees, Applicant respectfully requests a phone interview, and requests that the Examiner telephone the undersigned at 312-775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 13-Oct-2005

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